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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/680,604	10/06/2000	Dan Matheson	10003655-1	9577

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HEWLETT PACKARD COMPANY  
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INTELLECTUAL PROPERTY ADMINISTRATION  
FORT COLLINS, CO 80527-2400

EXAMINER
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CRAIG, DWIN M

ART UNIT	PAPER NUMBER
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2123

NOTIFICATION DATE	DELIVERY MODE
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10/28/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 09/680,604	<b>Applicant(s)</b> MATHESON, DAN	
	<b>Examiner</b> DWIN M. CRAIG	<b>Art Unit</b> 2123	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-34 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 21-34 have been presented based on Applicant's arguments.
2. Zoila E. Cabrera is no longer the Examiner of record, Dwin McTaggart Craig is now the Examiner of record.

### ***Response to Arguments***

3. Applicant's arguments presented in the 7/31/2008 responses have been fully considered; the Examiner's response is as follows:

3.1 On the first page of the response Applicant's persuasively argued that Eichstaedt is not a valid prior art reference because the provisional applications, specifically, 60/211285, 60/211254 and 60/228016 fail to provide the proper support for the cited sections of US Patent Publication 2005/0228793 to Eichstaedt, the Examiner has found this argument persuasive and hereby withdraws the previously applied prior art rejections under 35 U.S.C. § 102(e).

3.2 As regards Applicant's arguments in the section labeled, "Lack of Limitations" these arguments are moot in view of Eichstaedt not being a suitable prior art reference under 35 U.S.C. § 102(e).

3.3 An updated search has revealed new art.

### ***Claim Objections***

4. Claim 21 is objected to because the current claim language is grammatically awkward, for example, line 2 of the current claim language reads, "...*product using a computer a system that allows...*" underlining added. The Examiner assumes that Applicant's intended for the phrase to read, "...*product using a computer system that allows...*".

Clarification and amendment are required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 32-34 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 21-34 are rejected under 35 U.S.C. § 101 because all process claims ***must*** (1) be “*tied*” to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as article or materials) to a different state or thing.

### ***Claim Interpretation***

6. Applicant’s current claim language is broad and generic for example, independent claim 21, teaches, *a computer system for a first user to ask and then get an answer and then another user making a decision* i.e. a multi-user decision support system. ANY teaching of a computerized decision support system with a user interface reads on claim 21’s current claim language. The Applicant's are respectfully reminded that the Examiner is *required* to give the claim language the *Broadest Reasonable Interpretation of the Claims* during examination, see MPEP section 2111.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 21-34 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,517,405 to McAndrew, hereafter referred to as McAndrew.

7.1 As regards independent claim 1, *McAndrew* discloses, A method for handling an issue related to a design of product using a computer system that allows collaboration between a plurality of users, the method comprising: storing a question related to the issue, (Figure 2 item 72 “RETRIEVE/BUILD QUESTIONARE”) wherein the question is provided by a first user of the plurality of users; storing an answer related to the question, (see Figures 1 & 2 and the descriptive text more specifically, Col. 7 lines 14-37, “Thus, as new information (e.g., medical journal articles) becomes available, it is entered into the database **32** and will become available to a user via the information and synopsis subsystems **16, 18**, respectively...”, which is being interpreted to mean that the *answer* to a question is being supplied by a second user, which is the author of the medical journal article...) wherein the answer is provided by a second user of the plurality of users; and storing a decision made based on the answer, wherein the decision is made by a third user of the plurality of users (Col. 8 lines 31-25, “the user can refer the case to a more experienced reviewer, such as a physician, to make a final decision...”).

7.2 As to the dependent claims, 22-34, *McAndrew* teaches, (claim 22) a GUI, see Col. 1 lines 34-35, using the decision support system for a product (claim 23) Col. 5 lines 53-55, “industrial

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processes”, the system being “tool-neutral” which is being interpreted that it would be implemented on a variety of systems (claim 24) see Col. 6 lines 29-46 which describe one embodiment using a PC and Microsoft Windows™ however, another embodiment could be used and thus the disclosed teaching of *McAndrews* supports a *tool-neutral* system, a relational database (claim 25) see Col. 1 lines 29-44 and as regards claims 26-34 which claim *associations*, see the teaching of a relational database which has *associations* as regards questions and answers see Abstract, Col. 3 lines 6-18 and Col. 5 lines 25-40, and Col. 6 lines 10-13 and Figures 1 & 2 and the descriptive text regarding those Figures, i.e. Columns 1-14.

**8.** Claims 21-34 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,842,195 to *Peters et al.* hereafter referred to as *Peters*.

**8.1** As regards independent claim 1, *Peters* discloses, A method for handling an issue related to a design of product using a computer system that allows collaboration between a plurality of users, the method comprising: storing a question related to the issue, (Figure(s) 2, 5, 6, 7, 13 and the descriptive text regarding these figures) wherein the question is provided by a first user of the plurality of users; storing an answer related to the question, (Figure 10 “SAVE” and “SAVE AS...” see also Figure 11 and Col. 6 lines 53-59) wherein the answer is provided by a second user of the plurality of users; (Abstract, “...a plurality of computer users...” and Col. 6 lines 40-52 and Col. 6 lines 31-39) and storing a decision made based on the answer, wherein the decision is made by a third user of the plurality of users (as regards the teaching of an answer, see Col. 5 lines 25-37 and see the teaching of *branching decisions* which teaches the functionality of a

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*decision* see Col. 39 lines 23-45 and Col. 40 lines 1-45 more specifically, "...which make branching *decisions*..." *emphasis added*).

**8.2** As to the dependent claims, 22-34, *Peters* teaches, (claim 22) a GUI, see Figures 2-12 using the decision support system for a product Figure 6 (claim 23), the system being "tool-neutral" which is being interpreted that it would be implemented on a variety of systems, see (claim 24) which describe one embodiment using however, another embodiment could be used and thus the disclosed teaching of *Peters* supports a *tool-neutral* system see Col. 12 lines 8-10, "The E-Mail user may log onto *any* computer terminal and receive mail..." meaning that the system of *Peters* is *tool-neutral*, a relational database (claim 25) see Col. 3 lines 59-61, more specifically, "...relational database..." and as regards claims 26-34 which claim *associations*, see the teaching of a relational database which has *associations* as regards questions and answers see Col. 6 lines 23-30 which discusses *links* which are functionally the same as *associations*.

**9.** Claims 21-34 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,930,764 to *Melchoine et al.* hereafter referred to as *Melchoine*.

**9.1** As regards independent claim 1, *Melchoine* discloses, A method for handling an issue related to a design of product using a computer system that allows collaboration between a plurality of users, the method comprising: storing a question related to the issue, (Figure 1A and Col. 19 lines 46-51, "prompt the user by asking the right questions to generate parameters that can then be used to analyze the query in terms of paths...") wherein the question is provided by a first user of the plurality of users; storing an answer related to the question, (see Figures 11a & 11b and 12A & 12Ba and Col. 23 lines 3-5, "If the answer is the primary, then the outer Select

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looks at the household table.”) wherein the answer is provided by a second user of the plurality of users; (Figure 13H item labeled “CREDIT STATUS B,C,D see also Col. 45 lines 45-67) and storing a decision made based on the answer, wherein the decision is made by a third user of the plurality of users (Figures 13H & 13I and Col. 36 lines 44-58 and Col. 37 lines 5-10 and Col. 43 lines 1-4 which describes a decision support system and Col. 47 lines 13-15 more specifically, “The process can be repeated until all questions have been answered...” and Figure 12D and Col. 50 lines 34-67 “CREDIT DECISION” and Col. 51, 52, 53, 54, 55 and 56 lines 1-9).

**9.2** As to the dependent claims, 22-34, *Melchoine* teaches, (claim 22) a GUI, see Col. 8 line 34 “a graphical user interface (“GUI”)...” and Col. 27 lines 3-12 and as for using the decision support system for a product, see Col. 6 lines 25-67 and Col. 16 lines 15-28 more specifically, “for each product and service offered by the institution...” which describe supplying services for a financial product (claim 23), the system being “tool-neutral” which is being interpreted that it would be implemented on a variety of systems, see Col. 8 lines 32-41 more specifically “...that runs on a Windows™ PC or Macintosh™ computer...” (claim 24), as to a relational database (claim 25) see Figure 2 and Col. 3 lines 24-29, and as regards claims 26-34 which claim *associations*, see the teaching of a relational database which has *associations* as regards questions and answers see which are functionally the same as *associations* and Col. 3 lines 13-65 see also Figures 1-18c and the descriptive text more specifically Columns 1-58.

***Conclusion***

**10.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to DWIN M. CRAIG whose telephone number is (571)272-3710. The examiner can normally be reached on 10:00 - 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul L. Rodriguez can be reached on (571) 272-3753. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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